



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/945,038	08/31/2001	Ann Mond Johnson	2000874.00167US1	3056
23483	7590	07/02/2008	EXAMINER	
WILMERHALLE/BOSTON			COBANOGLU, DILEK B	
60 STATE STREET			ART UNIT	PAPER NUMBER
BOSTON, MA 02109			3626	
NOTIFICATION DATE		DELIVERY MODE		
07/02/2008		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

michael.mathewson@wilmerhale.com
teresa.carvalho@wilmerhale.com
sharon.matthews@wilmerhale.com

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ANN MOND JOHNSON,
TRACY J. HEILMAN,
JOSEPH DONLAN, and
JOHN FIACCO

Appeal 2008-1318
Application 09/945,038
Technology Center 3600

Decided: June 30, 2008

Before HUBERT C. LORIN, ANTON W. FETTING, and
MICHAEL W. O'NEILL, *Administrative Patent Judges*.

LORIN, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Ann Mond Johnson, et al. (Appellants) seek our review under 35 U.S.C. § 134 of the final rejection of claims 1-4. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

SUMMARY OF DECISION

We AFFIRM.¹

THE INVENTION

The invention relates to using a database to provide information.

Claim 1, reproduced below, is illustrative of the subject matter on appeal.

1. A method for providing healthcare information and treatment options for a previously diagnosed condition of a particular healthcare consumer, said method comprising the steps of:
 - without involving a medical professional:
 - providing, to the particular healthcare consumer, information relating to said previously diagnosed condition from at least one database, said information comprising, with respect to treating the previously diagnosed condition in other healthcare consumers, for each of a plurality of healthcare providers, a measure of the healthcare provider's charges and a measure of the healthcare provider's quality;
 - receiving, from the particular healthcare consumer, a plurality of criteria related to selecting a desired healthcare provider to treat the previously diagnosed condition; and
 - identifying, to the particular healthcare consumer, treatment options for said previously diagnosed condition, said identified treatment options comprising a listing of the plurality of healthcare providers ranked according to one or more of the prioritized criteria.

THE REJECTION

¹ Our decision will make reference to the Appellants' Appeal Brief ("Br.," filed Nov. 14, 2006) and the Examiner's Answer ("Answer," mailed Mar. 23, 2007).

The Examiner relies upon the following as evidence of unpatentability:

Papageorge	US 6,584,445 B2	Jun. 24, 2003
Perkins	US 5,724,379	Mar. 3, 1998

The following rejection is before us for review:

1. Claims 1-4 are rejected under 35 U.S.C. § 103(a) as unpatentable over Papageorge and Perkins.

ISSUES

The issue is whether the Appellants have shown that the Examiner erred in rejecting claims 1-4 under 35 U.S.C. § 103(a) as unpatentable over Papageorge and Perkins. A central issue is whether Papageorge and Perkins would suggest to one of ordinary skill to use a database to provide “information relating to [a] previously diagnosed condition ..., said information comprising, with respect to treating the previously diagnosed condition in other healthcare consumers, for each of a plurality of healthcare providers, a measure of the healthcare provider’s charges and a measure of the healthcare provider’s quality” (claim 1).

FINDINGS OF FACT

We find that the following enumerated findings are supported by at least a preponderance of the evidence. *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Office).

The scope and content of the prior art

1. Papageorge describes a system comprising a database for providing information. (See claims 1 and 8.) The type of information the database can provide relates to medical treatments and options. (See Fig. 2.)
2. Perkins relates to a computer system for comparing health care service providers. (Col. 1, ll. 56-64.)

Any differences between the claimed subject matter and the prior art

3. The difference between the claimed method and the cited prior art is that the cited prior art does not explicitly disclose using the database to provide “information relating to [a] previously diagnosed condition ..., said information comprising, with respect to treating the previously diagnosed condition in other healthcare consumers, for each of a plurality of healthcare providers, a measure of the healthcare provider's charges and a measure of the healthcare provider's quality” (claim 1).

The level of skill in the art

4. Neither the Examiner nor the Appellants have addressed the level of ordinary skill in the pertinent art of using databases. We will therefore consider the cited prior art as representative of the level of ordinary skill in the art. *See Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001) (“[T]he absence of specific findings on the level of skill in the art does not give rise to reversible error ‘where the prior art itself reflects an appropriate level and a need for testimony is not shown’”)(Quoting *Litton Indus. Prods., Inc. v. Solid State Sys. Corp.*, 755 F.2d 158, 163 (Fed. Cir. 1985)).

Secondary considerations

5. There is no evidence on record of secondary considerations of non-obviousness for our consideration.

PRINCIPLES OF LAW

“Section 103 forbids issuance of a patent when ‘the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.’” *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1734 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, and (3) the level of skill in the art. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). *See also KSR*, 127 S.Ct. at 1734 (“While the sequence of these questions might be reordered in any particular case, the [Graham] factors continue to define the inquiry that controls.”) The Court in *Graham* further noted that evidence of secondary considerations “might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented.” 383 U.S. at 17-18.

ANALYSIS

We have reviewed the record and conclude that the Appellants have not shown error in the rejection.

Claim 1

A claimed invention is unpatentable if the differences between it and the prior art are “such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art.” 35 U.S.C. § 103(a) (2000); *KSR Int'l v. Teleflex Inc.*, 127 S.Ct. 1727, 1734 (2007); *Graham v. John Deere Co.*, 383 U.S. 1, 13-14 (1966).

The subject matter of claim 1 as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art. Claim 1 describes a method of using a database. Claim 1 does not describe using the database in a manner different from the manner the database is used in Papageorge. Both claim 1 and Papageorge use a database to provide information.

The Appellants’ central argument is that the cited prior art would not suggest the database providing “information relating to [a] previously diagnosed condition ..., said information comprising, with respect to treating the previously diagnosed condition in other healthcare consumers, for each of a plurality of healthcare providers, a measure of the healthcare provider's charges and a measure of the healthcare provider's quality” (claim 1). (See Br. 8-9.) This argument is unpersuasive as to error in the rejection. The distinction based on a difference in the *type* of information a database is to provide is a distinction based on nonfunctional descriptive material. A distinction between claimed subject matter and the prior art over nonfunctional descriptive material is not patentably consequential.

The Appellants also argue that the instant receiving and identifying steps are not disclosed in the cited references. (Br. 9-10.) These claimed

steps are not however connected to any thing. Based on the broadest reasonable construction of the claim in light of the Specification as it would be interpreted by one of ordinary skill in the art, these steps encompass mental steps. Mental steps are not patentably consequential to the claimed method of using a database. *Comiskey* established that “the application of human intelligence to the solution of practical problems is not in and of itself patentable.” *In re Comiskey*, 499 F.3d 1365, 1379 (Fed. Cir. 2007).

The Appellants also argue that Papageorge teaches away from the claimed subject matter because the claim 1 describes practicing the method “without involving a medical professional” and Papageorge discloses using its system for patient and physician decision making. (Br. 11.) We do not find Papageorge teaches away from using the database without involving a medical professional. Papageorge uses the database in a medical environment but nowhere proscribes its use by other than medical professionals. Nevertheless, the use of any database, include the one claimed database, is not affected by who uses it.

Lastly, the Appellants criticize the Examiner’s teaching, suggestion, or motivation in combining the references to reach the claimed invention. (Br. 11-13.) However, the requirement of demonstrating a teaching, suggestion, or motivation (the so-called “TSM” test) to combine known elements in order to show that the combination is obvious may be “a helpful insight,” it cannot be used as a rigid and mandatory formula. *KSR* at 1741. While there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness, “the analysis need not seek out precise teachings directed to the specific subject matter of

the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *Id.* To establish a *prima facie* case of obviousness, the references being combined do not need to *explicitly* suggest combining their teachings. *See e.g., In re Kahn*, 441 F.3d 977, 987-88 (Fed. Cir. 2006) (“the teaching, motivation, or suggestion may be implicit from the prior art as a whole, rather than expressly stated in the references”). In determining whether the subject matter of a claim is obvious, “neither the particular motivation nor the avowed purpose of the [applicant] controls. What matters is the objective reach of the claim.” *Id.* at 1741-42. If the claim extends to what is obvious, it is unpatentable under § 103. In our view, claim 1 extends to what is obvious.

We have addressed the Appellants’ arguments. We sustain the rejection of claim 1.

Claim 2

We also sustain the rejection of claim 2.

The Appellants rely on arguments made with respect to the rejection of claim 1. (Br. 13.) Since we have not found them persuasive as to error in the rejection of claim 1, we find them equally unpersuasive as to error in the rejection of claim 2.

Claim 3

We also sustain the rejection of claim 3.

The Appellants argue that the correlating step of claim 3 is not described in the cited references. This claimed step is not however connected to any thing. Based on the broadest reasonable construction of the claim in light of the Specification as it would be interpreted by one of ordinary skill in the art, the correlating step encompass a step performed mentally. Mental steps are not patentably consequential to the claimed method of using a database. *Comiskey* established that “the application of human intelligence to the solution of practical problems is not in and of itself patentable.” *In re Comiskey*, 499 F.3d 1365, 1379 (Fed. Cir. 2007).

The Appellants also reiterate the argument made with respect to the rejection of claim 1 (and claim 2) that the Examiner has not provided adequate motivation for combining the references to reach the claimed invention. (Br. 15.) Since we have not found that argument persuasive as to error in the rejection of claim 1, we find it equally unpersuasive as to error in the rejection of claim 3.

Claim 4

We also sustain the rejection of claim 4.

The Appellants rely on arguments made with respect to the rejection of claim 1. (Br. 16.) Since we have not found them persuasive as to error in the rejection of claim 1, we find them equally unpersuasive as to error in the rejection of claim 4.

CONCLUSIONS OF LAW

We conclude the Appellants have failed to show that the Examiner erred in rejecting claims 1-4 under 35 U.S.C. § 103(a) as unpatentable over Papageorge and Perkins.

DECISION

The decision of the Examiner to reject claims 1-4 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv) (2007).

AFFIRMED

hh

WILMERHALE/BOSTON
60 STATE STREET
BOSTON MA 02109